



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,095	03/16/2001	Akinori Ohnishi	1035-311	8949

23117 7590 05/22/2006

NIXON & VANDERHYE, PC  
901 NORTH GLEBE ROAD, 11TH FLOOR  
ARLINGTON, VA 22203

EXAMINER
----------

KE, PENG

ART UNIT	PAPER NUMBER
----------	--------------

2174

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/809,095

Applicant(s)

OHNISHI, AKINORI

Examiner

Peng Ke

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-21, 23-25 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-21, 23-25, and 31-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This communication is responsive to Amendment filed 2/6/05.

This action is made final.

Claims 1-3, 5-21, 23-25, and 31-37 are pending in this application. Claims 1, 13, 24, 25, 32, 34, and 36 are independent claims. In the Amendment filed in 2/6/05, claims 4, 22, and 26-30 were cancelled, claims 1-3, 5, 13, 20, 21, 24, and 25 were added, and claims 31-37 were added.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 12, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu J.P. No. 2000-75984.

As per claim 1, Morris et al. teach an operation method for processing data file, comprising the steps of:

(a) displaying for each of one or more data files a reduced-size image/file icon pair wherein the reduced-size image is for use in identifying the contents of the data file and the corresponding file icon is spaced from the reduced-size image, and has a smaller area (see Morris

Art Unit: 2174

et al., figure 12B, items 809 and 807, column 6, lines 19 – 33, and column 15, lines 33 – 44; the examiner interprets the icons displayed in the thumbnail display as file icons and the scaled image as the reduced-size image);

(B) displaying one or more function icons on a second area of the display screen which is different than the first area of the display screen; (figure 10B, items 804 and 803) and

(C) performing at least either one of the operations of i) selecting a function to be applied to the data file and ii) changing a display position of the reduced-size image by a drag-and-drop operation on the file icon (see Morris et al., column 13, lines 37 – 67, and column 14, lines 1 – 11).

However Morris fails to teach the reduced-size image/file icon pair for each of the one or more data files is displayed on a first area of a display screen, where displaying the icon concurrently with the reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each of the reduced-size image/file icon pairs; and

Wherein the reduced-sized image for each reduced-size image/file icon pair is displayed so that each file icon is between its corresponding reduced-size image and the second area of the display screen.

Hirokazu et al. teaches the reduced-size image/file icon pair for each of the one or more data files is displayed on a first area of a display screen, (see Hirokazu paragraphs 0028-0032) where displaying the icon concurrently with the reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the

Art Unit: 2174

same for each of the reduced-size image/file icon pairs (see Hirokazu paragraphs 0026, 0028-0032);

Furthermore, because the second area of Morris is on the left side of the screen (figure 10 B, items 803) and reduce-size image of Hirokazu is on the right of icon, (figure 12, items 250 and 242) therefore the combination Morris Hirokazu would create a system where each file icon is between its corresponding reduced-size image and the second area of the display screen.

It would have been obvious to an artisan at the time of the invention to include S Hirokazu's teaching with the method of Morris in order to simplify presentation and selection of images over the web.

As per claim 3, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). Morris et al. further teach the method wherein:

in step (c), when the file icon is dropped at a position where no function icon representing a kind of a function to be applied to the data file is displayed, a display position of the corresponding reduced-size image is changed by moving the corresponding reduced-size image to a position at a predetermined interval from a dropped position of the file icon (see Morris et al, column 6, lines 37 – 67 and column 14, lines 1 – 11; it is inherent that there is no function icon when the thumbnail file icon is moved to a new position by a drag-and-drop operation, and when the icon is moved, the display position for the reduced-size image is changed to correspond to the changed position of the thumbnail file icon).

Art Unit: 2174

As per claim 12, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). Morris et al. further teach the operation method for processing data files as set forth in claim 1, wherein:

the file icon is displayed at positions in proximity of the reduced-size image (see Morris et al., figure 12b, items 809 and 807).

Displaying file icons corresponding to respective data files in a first area on a display screen, wherein images of contents of the data files are not perceivable from the file icons.

As per claim 31, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). Morris et al. further teaches the operation performed is selecting a function to be applied to one of the data files. (column 10, lines 11-55)

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu et al. J.P. No. 2000-75984 in view of Johnston, Jr. et al., U.S. Patent No. 5,598,524 and Belfiore et al., U.S. Patent No. 5,611,060.

As per claim 2, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). Morris et al. further teach the method wherein:

in the step (b), the reduced-size image is fixed at a current position while a drag operation on the file icon is being performed (see Morris et al., column 13, lines 37 – 67, and column 14, lines 1 – 11).

Morris et al. teach indicating a drag operation by a visual change (see Morris et al., column 13, lines 37 – 62). They do not teach indicating a drag operation by displaying a frame having the size of the reduced size image. Johnston, Jr. et al. teach displaying a frame having the size of a display object as it is dragged (see Johnston, Jr. et al., figures 13a, items 1300 and 1310 and column 13, lines 25 – 33).

Morris et al. teach performing an action when a threshold is breached during a drag operation (see Morris et al., column 13, lines 37 – 62; the display order is changed when the thumbnail is dragged onto a different part of the screen). Morris et al. do not teach performing an action if a drag speed threshold is breached while dragging. Belfiore et al. teach performing an action if a drag speed threshold is breached while dragging (see Belfiore et al., column 3, lines 45 – 60). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Johnston et al. and Belfiore et al. with the method of Morris et al. and Hirokazu in order to provide an improved method of providing visual feedback when a threshold is breached.

Claims 5 – 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu J.P. No. 2000-75984 further in view of Hirose, U.S. Patent No. 5,745,112.

As per claim 5, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). They do not teach the method wherein:

in step (c), when the file icon has moved to a position more than a predetermined distance apart from the corresponding reduced-size image, an icon return space is displayed at or in a proximity to the original display position of the file icon, at a predetermined fixed interval from the reduced-size image.

Hirose teaches when an icon is moved, an icon return space is displayed at or in a proximity to the original display position of the icon (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; the examiner interprets the dotted line 311 as a return space as it is located at the original position of the file icon 303). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Hirose with the method of Morris et al. and Hirokazu in order to display the area in which an icon was originally located when the icon has been dragged and moved from its original location.

As per claim 6, which is dependent on claim 5, Morris et al., Hirokazu and Hirose teach the method of claim 5 (see rejection above). Hirose further teaches in step (c), when the file icon is dropped in the icon return space, the file icon is moved back to its original display position without moving the associated reduced-size image (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; it is inherent that when the icon is dropped in the return space it will be in its original position and no changes will occur because the return space is the original location of the icon).

As per claim 7, which is dependent on claim 5, Morris et al. Hirokazu and Hirose teach the method of claim 5 (see rejection above). Hirose further teaches the method wherein the icon



Art Unit: 2174

return space is formed in an outstanding pattern (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; the examiner interprets a dotted line as an outstanding pattern).

As per claim 11, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). They do not teach the operation method for processing data files as set forth in claim 1, wherein:

the icon return space is displayed in a different manner than the file icon when the file icon has moved to a position at a predetermined position from an original position.

Hirose teaches wherein the icon return space is displayed in a different manner than the file icon when the file icon has moved to a position at a predetermined position from an original position (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; the examiner interprets the dotted line 311 as a return space as it is located at the original position of the file icon 303). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Hirose with the method of Morris et al. and Hirokazu in order to clearly display the area in which an icon was originally located when the icon has been dragged and moved from its original location.

Art Unit: 2174

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu J.P. No. 2000-75984 in view of Hirose, U.S. Patent No. 5,745,112 further in view of Aparicio, IV et al., U.S. Patent No. 5,727,174.

As per claim 8, which is dependent on claim 5, Morris et al. Hirokazu and Hirose teach the method of claim 5 (see rejection above). They do not teach displaying an icon return space. Hirose teaches displaying an icon return space but do not teach wherein the icon return space is larger in size than the icon. Aparicio, IV et al. teach a method wherein an icon return space is larger in size than the file icon (see Aparicio, IV, figure 6, items 47, and 49; the examiner interprets the empty mini-desk icon area as the return space, it is inherent that the assistant icon is smaller in size than the return space). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Aparicio, IV et al. with the method of Morris et al. Hirokazu and Hirose in order to provide a clearer indication to the user of the original location of an icon.

Claims 9, 13, 14, 20 – 21, 23-25, and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu J.P. No. 2000-75984 further in view of Johnston, Jr. et al., U.S. Patent No. 5,598,524.

Art Unit: 2174

As per claim 9, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). They do not teach the operation method for processing data files as set forth in claim 1, wherein:

a function icon is displayed with substantially the same size as the file icon when the file icon is displayed.

Johnston, Jr. et al. teaches wherein a function icon is displayed with substantially the same size as the file icon when the file icon is displayed (see Johnston, Jr. et al., figures 9a – 9d, items 905 and 920). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Johnston, Jr. et al. with the method of Morris et al. and Hirokazu in order to provide a consistent look for a graphical user interface.

As per claim 10, which is dependent on claim 1, Morris et al. and Hirokazu teach the method of claim 1 (see rejection above). They do not teach the operation method for processing data files as set forth in claim 1, wherein:

a display of one or both of a function icon and an icon return space is changed when the file icon overlaps the function icon when the file icon is dragged.

Johnston, Jr. et al. teaches a display of one or both of a function icon and an icon return space is changed when the file icon overlaps the function icon when the file icon is dragged (see Johnston, Jr. et al., figure 17, item 1704 and column 14, lines 45 – 67). It would have been obvious to one of ordinary skill in the art at the time of the invention

Art Unit: 2174

to incorporate the method of Johnston, Jr. et al. with the method of Morris et al. and Hirokazu in order to provide positive drag destination feedback to a user.

As per claim 13, Morris et al. teach a method, comprising:

generating a display that comprises a reduced-size image/file icon pair for each of one or more data files, wherein the reduced-sizes image permits an identification of the contents of the data file and the file icon is smaller than, and spaced from, the reduced-sized image (see Morris et al., figure 12B, items 809 and 807, column 6, lines 19 – 33, and column 15, lines 33 – 44; the examiner interprets the icons displayed in the thumbnail display as file icons and the scaled image as the reduced-size image); and

moving the reduced-sized image from an original display position in response to user inputs supplied via an input device for moving the file icon from an original display position to another display position (see Morris et al., column 13, lines 37 – 67, and column 14, lines 1 – 11).

Morris et al. do not teach processing the data file in accordance with a function in response to user inputs supplied via the input device for moving the file icon from an original display position to a function invoking position on the display that invokes the function. Johnston, Jr. et al. teach processing a data file in accordance with a function in response to user inputs supplied via the input device for moving a file icon from an original display position to a function invoking position on the display that invokes the function (see Johnston, Jr. et al., column 12, lines 12 – 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of

Art Unit: 2174

Johnston, Jr. et al. with the method of Morris et al. in order to provide an improved method of accessing a commonly used function.

However they both fail to teach teach the reduced-size image/file icon pair for each of the one or more data files is displayed on a first area of a display screen, where displaying the icon concurrently with the reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each of the reduced-size image/file icon pairs; and

Wherein the reduced-sized image for each reduced-size image/file icon pair is displayed so that each file icon is between its corresponding reduced-size image and the second area of the display screen.

Hirokazu et al. teaches teaches the reduced-size image/file icon pair for each of the one or more data files is displayed on a first area of a display screen, (see Hirokazu paragraphs 0028-0032) where displaying the icon concurrently with the reduced image wherein the display position of the file icon relative to the display position of the reduced-size image is predetermined to be the same for each of the reduced-size image/file icon pairs (see Hirokazu paragraph 0026, 0028-0032);

Furthermore, because the second area of Morris is on the left side of the screen (figure 10 B, items 803) and reduce-size image of Hirokazu is on the right of icon, (figure 12, items 250 and 242) therefore the combination Morris Hirokazu would create a system where each file icon is between its corresponding reduced-size image and the second area of the display screen.

It would have been obvious to an artisan at the time of the invention to include Hirokazu's teaching with the method of Morris and Johnston, Jr. in order to simplify presentation and selection of images over the web.

As per claim 14, which is dependent on claim 13, Morris et al. Hirokazu and Johnston, Jr. et al. teach the method of claim 13 (see rejection above). Morris et al. further teach the method according to claim 13, wherein the user inputs for moving the file icon from its original display position to another display position comprise inputs for dragging-and-dropping the file icon (see Morris et al., column 13, lines 36 – 40).

As per claim 20, which is dependent on claim 13, Morris et al. Hirokazu and Johnston, Jr. et al. teach the method of claim 13 (see rejection above). Morris et al. does not teach the method according to claim 13, wherein the user inputs for moving the file icon to the function-invoking position comprise inputs for dragging and dropping the file icon onto one of one of more function icons. Johnston, Jr. et al. teaches wherein the user inputs for moving the file icon to the function-invoking position comprise inputs for dragging and dropping the file icon onto the function icon. (see Johnston, Jr. et al., column 12, lines 10 – 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Johnston, Jr. et al. with the method of Morris et al. in order to provide an improved method of accessing a commonly used function.

As per claim 21, which is dependent on claim 20, Morris et al. Hirokazu and Johnston, Jr. et al. teach the method of claim 20 (see rejection above). Morris et al. does not teach the method according to claim 20, wherein the one or more function icons have substantially the same size as the file icons. Johnston, Jr. et al. teaches wherein the function icon has substantially the same size as the file icons (see Johnston, Jr. et al., figures 9a – 9d, items 905 and 920). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Johnston, Jr. et al. with the method of Morris et al. in order to provide a consistent look for a graphical user interface.

As per claim 23, which is dependent on claim 13, Morris et al. Hirokazu and Johnston, Jr. et al. teach the method of claim 13 (see rejection above). Morris et al. does not teach the method according to claim 13, wherein the function in accordance with which the data file is processed is selected from the group consisting of a printing function, a facsimile function, and an e-mail function. Johnston, Jr. et al. teaches wherein the function in accordance with which the data file is processed is selected from the group consisting of a printing function, a facsimile function, and an e-mail function (see Johnston, Jr. et al., column 12, lines 28 – 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of

Art Unit: 2174

Johnston, Jr. et al. with the method of Morris et al. Savitzky in order to provide a consistent look for a graphical user interface.

As per claims 24, 25, 32, 34, and 36, they are of similar scope to claim 13 and are rejected under the same rationale.

As per claims 33, 35, and 37, they are of similar scope to claim 21 and are rejected under the same rationale.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu J.P. No. 2000-75984 in view of Johnston, Jr. et al., U.S. Patent No. 5,598,524 further in view of Fleming, U.S. Patent No. 5,392,389.

As per claim 15, which is dependent on claim 14, Morris et al. Hirokazu and Johnston, Jr. et al. teach the method of claim 14 (see rejection above). They do not teach the method according to claim 14, wherein the reduced-size image is moved from its original position to a position adjacent to the position at which the file icon is dropped. Fleming teaches wherein a reduced-size image is moved from its original position to a position adjacent to the position at which the file icon is dropped (see Fleming, figures 4, 5 and 6, items 27 and 29, and column 3, line 62 – column 4, line 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the



Art Unit: 2174

method of Fleming with the method of Morris et al. Hirokazu and Johnston, Jr. et al. in order to provide a clear indication of a move operation to the user.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu J.P. No. 2000-75984 in view of Johnston, Jr. et al., U.S. Patent No. 5,598,524 further in view of Hirose, U.S. Patent No. 5,745,112.

As per claim 16, which is dependent on claim 13, Morris et al. in view of Hirokazu and Johnston, Jr. et al. teach the method of claim 13 (see rejection above). They do not teach the method according to claim 13, further comprising:

displaying a file icon return space when the file icon is moved more than a predetermined distance from the reduced-size image.

Hirose teaches displaying a file icon return space when the file icon is moved more than a predetermined distance from the reduced-size image (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; the examiner interprets the dotted line 303 as a return space as it is located at the original position of the file icon 303). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Hirose with the method of Morris et al. Hirokazu and Johnston, Jr. et al. in order to display the area in which an icon was originally located when the icon has been dragged and moved from its original location.

Art Unit: 2174

As per claim 17, which is dependent on claim 16, Morris et al. Hirokazu et al., Johnston, Jr. et al. and Hirose teach the method of claim 16 (see rejection above). Morris et al. Hirokazu and Johnston, Jr. et al. do not teach the method according to claim 16, further comprising:

returning the file icon back to its original display position if the file icon is moved to the file icon return space.

Hirose teaches returning the file icon back to its original display position if the file icon is moved to the file icon return space (see Hirose, figure 7, ref. 311 and 303 and column 4, lines 19 – 24; it is inherent that when the icon is dropped in the return space it will be in its original position and no changes will occur because the return space is the original location of the icon).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu et al. J.P. No. 2000-75984 in view of Johnston, Jr. et al., U.S. Patent No. 5,598,524 further in view of Hirose, U.S. Patent No. 5,745,112 further in view of Aparicio, IV et al., U.S. Patent No. 5,727,174.

As per claim 18, which is dependent on claim 16, Morris et al., Savitzky, Johnston, Jr. et al. and Hirose teach the method of claim 16 (see rejection above). Morris et al. Hirokazu and Johnston, Jr. et al. do not teach the method according to claim 16, wherein the file icon return space has a larger area than the file icon. Hirose

Art Unit: 2174

teaches displaying an icon return space but does not teach wherein file icon return space has a larger area than the file icon. Aparicio, IV et al. teach a method wherein the file icon return space has a larger area than the file icon (see Aparicio, IV, figure 6, items 47, and 49; the examiner interprets the empty mini-desk icon area as the return space, it is inherent that the assistant icon is smaller in size than the return space). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Aparicio, IV et al. with the method of Morris et al., Hirokazu, Johnston, Jr. et al. and Hirose in order to provide a more clear indication to the user of the original location of an icon.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al., U.S. Patent No. 6,097,389 in view of Hirokazu et al. J.P. No. 2000-75984 in view of Johnston, Jr. et al., U.S. Patent No. 5,598,524 further in view of Belfiore et al., U.S. Patent No. 5,611,060.

As per claim 19, which is dependent on claim 13, Morris et al. Hirokazu and Johnston, Jr. et al. teach the method of claim 13 (see rejection above). Morris et al. teach moving a reduced-size image in response to user input of moving the file icon (see rejection for claim 13). Morris et al. further teach indicating a move operation by a visual change (see Morris et al., column 13, lines 37 – 62).

• Art Unit: 2174

Morris et al. and Hirokazu do not teach representing the reduced-size image with a frame while moving the file icon. Johnston, Jr. et al. teach displaying a frame of a display object as it is dragged (see Johnston, Jr. et al., figures 13a, items 1300 and 1310 and column 13, lines 25 – 33).

Morris et al. teach performing an action when a threshold is breached during a drag operation (see Morris et al., column 13, lines 37 – 62; the display order is changed when the thumbnail is dragged onto a different part of the screen). Morris et al. do not teach performing an action if a movement speed is below a predetermined speed and not performing an action when the movement speed is above a predetermined speed. Belfiore et al. teach performing an action if a drag speed is below a predetermined speed and not performing an action if a drag speed is above a predetermined speed (see Belfiore et al., column 3, lines 45 – 60; it is inherent that the automatic scrolling will not be initiated when the speed is above a predetermined speed threshold).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the methods of Johnston et al. and Belfiore et al. with the method of Morris et al. and Hirokazu in order to provide improved visual feedback when a threshold is breached.

### ***Response to Argument***

Applicant's arguments filed on 2/6/05 have been fully considered but they are not persuasive.

Applicant's argument focused on the following:

1) There is no reason to combine Morris with Hirokazu.

2) There is no reason to combine Johnston with Belfiore.

Examiner disagrees.

1) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Hirokazu provided a reason for combining his method with another invention and that is to create a graphic operating method which facilitates the selection of one arbitrary graphic or one window from multiple graphics or windows displayed by overlapping them on the screen of a display unit and can facilitate the movement of said selected graphics or windows or operations such as size change, etc. in a graphic processing system. (see Hirokazu, paragraph 0006)

Morris' users cannot easily recognize the correspond of a window and display on a window and a display on a window graph corresponding to the window because the display window and the window graph are displayed at separated positions. Therefore it would be obvious to combine Hirokazu's teaching with Morris' method.

2) The systems of Morris, Hirokazu, and Johnston, Jr have a window system that uses a scrolling system to view contents that cannot fit in the display area. Belfiore provided a scrolling system that minimizes unwanted scrolling that can cause the user to perform their work

Art Unit: 2174

less efficiently, as well as lead to user frustration. (column 2, lines 40-55) Therefore it would be obvious to combine Hirokazu's teaching with Morris' method.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peng Ke

*Kristine Kincaid*  
KRISTINE KINCAID  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100